

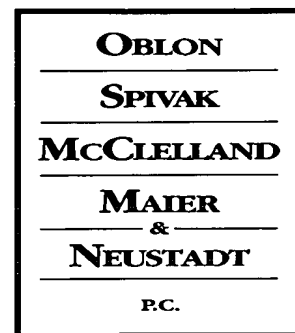
1637



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Docket No.: 196737US0PCT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 09/622,915
Applicants: Eiichi NAKAMURA, et al.
Filing Date: November 17, 2000
For: FULLERENE DERIVATIVES
Group Art Unit: 1637
Examiner: RILEY, J.

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OCT 29 2003

TECH CENTER 1600/2900

SIR:

Attached hereto for filing are the following papers:

Response to Restriction Requirement

Our check in the amount of -0- is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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U.S. Application No. 09/622,915
Reply to Office Action dated September 26, 2003
DOCKET NO.: 196737US0PCT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :
EIICHI NAKAMURA ET AL : GROUP ART UNIT: 1637
SERIAL NO.: 09/622,915 :
FILED: NOVEMBER 17, 2000 : EXAMINER: RILEY, J.
FOR: FULLERENE DERIVATIVES

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RESPONSE TO RESTRICTION REQUIREMENT

TECH CENTER 1600/2900

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Responsive to the Office Action dated September 26, 2003, Applicants elect, with traverse, Group III, Claims 51-58 for prosecution.

REMARKS

The Examiner has required restriction in the above-identified application as follows:

Group I: Claims 23-30, 34-41, and 45-47;

Group II: Claims 23-27, 31-38, 42-44, and 48-50;

Group III: Claims 51-58; and

Group IV: Claims 51-55 and 59-61.

Applicants have elected, with traverse, Group III, Claim 51-58.

The Examiner, citing PCT Rule 13.1 and 13.2, contends that Groups I-IV do not relate to a single general inventive concept because they lack the same or corresponding special technical features. Specifically, the Office argues that the application lacks unity of invention

because the inventions of Groups I and III use a special technical feature which is chemically different from the special technical feature of Groups II and IV.

The Applicants respectfully traverse the Restriction Requirement on the ground that unity of invention does exist between Groups I-IV because there is a technical relationship that involves the same special technical feature. Specifically, all of the pending claims share the common special technical feature of “contacting DNA with a fullerene derivative having 1 to 4 nitrogen-containing hydrophilic side chains or a salt thereof.” This is made clear by the fact that Claim 23 is common to both Groups I and II, and Claim 51 is common to both Groups III and IV. It is this technical feature that defines the contribution which each of the Groups, taken as a whole, makes over the prior art.

Applicants further traverse the Restriction Requirement on the ground that the Office has failed to follow MPEP guidelines for making a lack of unity of invention requirement between restricted Groups. MPEP §1893.03(d) states:

“When making a lack of unity of invention requirement, the Examiner must (1) list different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.”

The Examiner has not explained why each group lacks unity with each other group and has not specifically described the unique special technical features in each group to justify the conclusion of a lack of unity of invention. Accordingly, Applicants respectfully submit that the present Restriction Requirement is improper, and that the Restriction Requirement be withdrawn.

Moreover, the MPEP in §803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

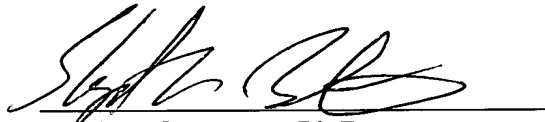
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Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'Stephen G. Baxter', is written over a horizontal line.

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